

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed on January 23, 2009. Upon entry of this response, claims 1-16, 20-25, 27-65, 69-97, and 112-115 are pending in the application. In this response, claim 1, 30, and 49 has been amended to remove duplicate punctuation (e.g., ".") in the case of claim 30 and correct for proper antecedent basis in claims 1 and 49. Applicant respectfully requests that the amendment being filed herewith be entered and request reconsideration and allowance of all pending claims.

#### **I. Claim Rejections under 35 U.S.C. §102(e)**

Claims 1-16, 20-24, 27-45, 49-65, 69-73, 75-94, and 112-115 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Ukai et al.* (U.S. Pat. No. 7,096,486, hereafter "*Ukai*"). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every claimed feature is represented in the *Ukai* reference. Applicant discusses the *Ukai* reference and Applicant's claims in the following.

**A. Independent Claim 1**

Applicant's amended claim 1 provides as follows (emphasis added):

1. A method for providing television functionality comprising:
  - tracking a plurality of viewing parameters corresponding to services that are provided to a user;
  - determining a user preference for each of the plurality of viewing parameters;
  - tracking the user preference by assigning a score to each of the plurality of viewing parameters;
  - weighting the scores;**
  - determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user;**
  - receiving user input requesting television functionality; and
  - providing the user with a result that is responsive to the user input and to the overall user preference score.

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Ukai* does not disclose, teach, or suggest at least the features recited and emphasized above in amended claim 1. The non-final Office Action (page 6) refers to Figure 6 of *Ukai* and alleges that the claimed **viewing parameters** are represented by "program name, date and time, genre, time period, language and preference measure. In addition, the non-final Office Action (page 7) refers to Figure 4 of *Ukai* and alleges that the claimed **user preference** is represented by "view time period." Further, the non-final Office Action (page 7) refers to Figure 5 of *Ukai* and alleges that the claimed **assigning a score** is represented by the "view score." The non-final Office Action (page 7) alleges the following with regard to the claimed **weighting of scores**:

Ukai also discloses weighting the scores (see Figure 5 and Column 5, Lines 45-55 for weighting the view scores by calculating a program view measure, which represents a weight that is adjusted each time a view score is added to the database (i.e. the program was viewed).

Applicant respectfully disagrees. A "program view measure" (e.g., 504 in Figure 5 of *Ukai*, which appears to be a tally of serial program views) is a score that is separate and distinct from

the first or second view scores (e.g., 502 and 504 in Figure 5 of *Ukai*, which each comprises the view time duration divided by the program time duration). Applicant sees no evidence in *Ukai* of a weight applied to the “view score.” For at least this reason, the rejection should be withdrawn.

In addition, the non-final Office Action appears to be taking an overly broad interpretation of the term ***weighting*** that is not supported by the plain ordinary meaning of the term. For instance, according to the interpretation from the non-final Office Action (page 7), program view measure is a weight since it “is adjusted each time a view score is added to the database.” Such an adjustment according to *Ukai* is one of “dividing the sum of view scores by the number of serials of the series program,” (see, e.g., col. 5, lines 42-47, *Ukai*) which more reasonably would sound to one having ordinary skill in the art as averaging. As for guidance as to how one having ordinary skill in the art would construe the plain and ordinary meaning of the term “weighting,” one need look no further than the evidence on record (e.g., *Ukai*) as one example of weighting (col. 6, lines 34-38, *Ukai*), which discloses the following (emphasis added):

A weighted program view measure in the weighted program view measure section 703 is obtained by multiplying a program view measure in the program view measure column 504 of the corresponding program shown in the view history table 500 by a value not smaller than 1.

However, Applicant does not intend to limit the definition of ***weighting*** to merely the evidence of record. Even assuming a broader interpretation than that which is described in *Ukai*, it appears unreasonable to “weight” an already weighted value, since as shown in this recited section of *Ukai*, the “program view measure” is weighted when incorporated into Figure 7. Applicant respectfully submits that one having ordinary skill in the art would not reasonably construe averaging to be weighting, especially in view of the record, nor construe the claims in this nonsensical approach (e.g., multiple levels of weighting) taken by the non-final Office Action. As set forth according to well-established case law,

\*\*>Although< claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims

must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, \*415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*).

Since averaging would be viewed by one having ordinary skill in the art as an entirely different concept than weighting, as evidenced by the record, and that the construction alleged in the non-final Office Action is nonsensical and unreasonable, Applicant respectfully submits that the rejection should be withdrawn for this additional and separate reason.

Continuing, the non-final Office Action (pages 7-8) alleges the following with regard to the claimed overall user preference score (emphasis in original):

Ukai also discloses determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of weighted scores associated with each of the plurality of tracked viewing parameters for the user (see Figure 7 and Column 6, Lines 21-52 for the system calculating a preference measure conversion table 700 for estimating degrees of viewer's preference for programs to be broadcasted, where the system further calculates a weighted program view measure 703 which is determined using the program view measure 504). *The examiner further notes that the total number of programs represents a weighted linear combination because if one user [watches]sic a program 19 times and a second user watches a program 10 times, this represents a different weight in regards to the interest the user has in the program.*

Applicant respectfully submits that it is unclear from the non-final Office Action what constitutes the claimed **overall user preference score**, and hence respectfully requests clarification in any further action not constituting an allowance. Applicant will assume for the sake of argument that the alleged equivalent to **overall user preference score** is intended by the non-final Office Action to be the "total view score 714" in Figure 7. The rejection of the claim features, **weighting of scores**, appears to rely on the "program view measure 504" of Figure 5 as set forth above. As explained above, the program view measures do not constitute **the weighted scores** as claimed. However, as set forth in col. 6, lines 34-38 of *Ukai* (reproduced above), the

program view measure 504 appears to be weighted (703). The weighted program view 703 is combined with other elements in Table 700 (Figure 7) to compute a total view score 714 (e.g., see col. 8, line 54 – col. 9, line 20 of *Ukai*), but clearly the computation for 714 does not involve a linear combination of weighted program view measures 703 (assuming *arguendo* equivalent to the claimed **overall user preference score**), but only one. For at least this additional reason, Applicant respectfully requests that the rejection be withdrawn.

Further, Applicant is perplexed by the allegation on pages 7-8 of the non-final Office Action that the “total number of programs represents a weighted linear combination.” Claim 1 requires a “linear combination of weighted scores,” which clearly is not represented by a number of programs 603. If the intent of this rejection is to say that the specific view scores somehow represents the claimed weighted scores through incorporation of the number of programs in the computation of specific view scores, then again, one having ordinary skill in the art would need to unreasonably construe *Ukai* to implement multiple levels of weight-application (e.g., to view measure 504, to specific view scores 604, and to the weighted program view measure 702). This multi-level application of weights is simply not supported in *Ukai*, especially in view of the fact that when *Ukai* intends to weight a value, it expressly manifests the language to convey that concept. At best, the approach taken by the non-final Office Action is based on improper hindsight that attempts to use Applicant’s claims as a map to piece-meal the rejection of individual claim elements. For this additional reason, Applicant respectfully requests that the rejection be withdrawn.

Since independent claim 1 is allowable, Applicant respectfully submits that claims 2-16, 20-24, and 27-45, and 112-113 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicant respectfully requests that the rejection of claims 2-16, 20-24, and 27-45, and 112-115 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 3 and 4 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 3 and 4. Specifically, Applicant's claims 3 and 4 provide as follows (emphasis added):

3. The method of claim 1, where ***the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user.***

4. The method of claim 1, where ***the user preference is determined based on a duration and a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user.***

The non-final Office Action (page 8), like the final rejection (pages 4-5), alleges that “*Ukai* discloses that the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user **(see Figure 6 for determining a user preference 604 based on a number of programs 603 viewed)**” (emphasis in original). This rebuttal argument from the previous response has not been addressed in the non-final Office Action. Applicant respectfully submits that “a frequency that a service ... is presented to the user” is not the same as a number of programs viewed. Frequency implies a per-time period basis, which *Ukai* fails to teach.

Further, the non-final Office Action (page 9) refers to the rejection of claims 2 and 3 on page 8) for alleged support in *Ukai* for anticipation of the above-emphasized claim features. The rejection appears to allege that based on 404 (view time period) and 604 (specific view score), the above-emphasized features are shown. Applicant respectfully disagrees, and notes that *Ukai* does not teach or suggest that view time period 404 is determined based on “a frequency that a service ... is presented to the user” as recited in claims 3 and 4. Again, frequency implies a per time period basis that is absent in *Ukai*.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 3 and 4. Therefore, Applicant respectfully requests that the rejections of claims 3 and 4 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claim 6 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claim 6. Specifically, Applicant's claim 6 provides as follows (emphasis added):

6. The method of claim 1, where ***the user preference conflicts with another user preference.***

The non-final Office Action alleges on page 9 that “Ukai discloses that the user preference conflicts with another user preference (**see Figure 3 and note that the two programs in table 300 are show at two overlapping/conflicting time periods in table entries 303**)” (emphasis in original). However, the Advisory Action on page 2 states that “Ukai clearly teaches determining a user preference (**view time period 404 in Figure 4**) for each of the plurality of viewing parameters (**each program name in Figure 4**)” (emphasis in original). As such, the Advisory Action appears to allege that view time period 404 corresponds to “a user preference”. Applicant respectfully submits that *Ukai* does not teach or suggest that a view time period 404 “conflicts with another” view time period 404. Further, the table 300 is based on an EPG, and does not yet correspond to user preferences as derived from Figure 6 of *Ukai*. To allege otherwise is to say that everything in an EPG is a user preference, which obviates the need for the invention disclosed in *Ukai* and hence is an improper and unreasonable construction.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claim 6. Therefore, Applicant respectfully requests that the rejection of claim 6 be withdrawn.

Both the non-final Office Action (page 10) and, as expressed in the last response, the final Office Action (page 6) alleges that “Referring to claims 10-12, see the rejection of claims 1 and 9. Applicant respectfully submits that this vague rejection of Applicant's claim limitations is improper. In particular, the MPEP points out in § 707.07(d) under “Improperly Expressed Rejections” that:

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

Applicant submits that the rejection of claims 1 and 9 is not equally applicable to claims 10-12 because each claim contains different features. Specifically, Applicant's claims 10-12 provide as follows (emphasis added):

10. The method of claim 9, where ***the preference adaptive mode is activated via a switch located on a remote control device.***

11. The method of claim 1, where ***user preference is determined based on user input.***

12. The method of claim 11, where ***the user input indicates a preference for a viewing parameter.***

Applicant respectfully submits that the features recited and emphasized above in claims 10-12 are not included in claims 1 and 9. As such, the non-final and final Office Actions both fail to present a *prima facie* case of obviousness against claims 10-12 for at least the reason that it fails to articulate a finding that the cited references include each element claimed. Accordingly, Applicant respectfully requests that the rejection of claims 10-12 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 13 and 14 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 13 and 14. Specifically, Applicant's claims 13 and 14 provide as follows (emphasis added):

13. The method of claim 11, where ***the user input indicates a preference against one or more of the plurality of viewing parameters.***

14. The method of claim 11, where ***the user input indicates a preference for a first viewing parameter and a preference against a second viewing parameter***, said first and second viewing parameters comprise the plurality of viewing parameters.

The non-final Office Action (page 10) and final Office Action (page 6) alleges that “*Ukai* discloses that the user input indicates a preference against one or more of the plurality of viewing parameters (***see Figure 5 for the user viewing a program for a first time and second time, thereby showing entering a first time against a second time***)” (emphasis in



original). However, the Advisory Action on page 2 states that “the view time period represents how interested the user [is] in the television program based on how long the user watches the television program.” Thus, Applicant respectfully submits that “viewing a program” is not the same as “indicat[ing] a preference against one or more ... viewing parameters”. Further, Applicant respectfully submits that *Ukai* does not teach or suggest “indicat[ing] a preference against one or more ... viewing parameters”.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 13 and 14. Therefore, Applicant respectfully requests that the rejections of claims 13 and 14 be withdrawn.

#### **B. Independent Claim 49**

Applicant’s amended claim 49 provides as follows (emphasis added):

49. A system for providing television functionality comprising:
- logic for tracking a plurality of viewing parameters corresponding to services that are provided to a user;
  - logic for determining a user preference for each of the plurality of viewing parameters;
  - logic for tracking the user preference by assigning a score to each of the plurality of viewing parameters;
  - logic for weighting the scores;***
  - logic for determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user;***
  - logic for receiving user input requesting television functionality; and
  - logic for providing the user with a result that is responsive to the user input and to the overall user preference score.

Applicant respectfully submits that independent claim 49 is allowable for at least the reason that *Ukai* does not disclose, teach, or suggest at least the features recited and emphasized above in amended claim 49. The non-final Office Action (page 12) refers to the rejections to method claims 1-16, 20-24, and 27-45 for application to claims 49-65, 69-73, and 75-94. Applicant addresses the rejections below in the context of the arguments made in the Office Action to the

method claims. The non-final Office Action (page 6) refers to Figure 6 of *Ukai* and alleges that the claimed **viewing parameters** are represented by “program name, date and time, genre, time period, language and preference measure. In addition, the non-final Office Action (page 7) refers to Figure 4 of *Ukai* and alleges that the claimed **user preference** is represented by “view time period.” Further, the non-final Office Action (page 7) refers to Figure 5 of *Ukai* and alleges that the claimed **assigning a score** is represented by the “view score.” The non-final Office Action (page 7) alleges the following with regard to the claimed **weighting of scores**:

Ukai also discloses weighting the scores (see Figure 5 and Column 5, Lines 45-55 for weighting the view scores by calculating a program view measure, which represents a weight that is adjusted each time a view score is added to the database (i.e. the program was viewed).

Applicant respectfully disagrees. A “program view measure” (e.g., 504 in Figure 5 of *Ukai*, which appears to be a tally of serial program views) is a score that is separate and distinct from the first or second view scores (e.g., 502 and 504 in Figure 5 of *Ukai*, which each comprises the view time duration divided by the program time duration). Applicant sees no evidence in *Ukai* of a weight applied to the “view score.” For at least this reason, the rejection should be withdrawn.

In addition, the non-final Office Action appears to be taking an overly broad interpretation of the term **weighting** that is not supported by the plain ordinary meaning of the term. For instance, according to the interpretation from the non-final Office Action (page 7), program view measure is a weight since it “is adjusted each time a view score is added to the database.” Such an adjustment according to *Ukai* is one of “dividing the sum of view scores by the number of serials of the series program,” (see, e.g., col. 5, lines 42-47, *Ukai*) which more reasonably would sound to one having ordinary skill in the art as averaging. As for guidance as to how one having ordinary skill in the art would construe the plain and ordinary meaning of the term “weighting,” one need look no further than the evidence on record (e.g., *Ukai*) as one example of weighting (col. 6, lines 34-38, *Ukai*), which discloses the following (emphasis added):

A weighted program view measure in the weighted program view measure section 703 is obtained by multiplying a program view measure in the program view measure column 504 of the corresponding program shown in the view history table 500 by a value not smaller than 1.

However, Applicant does not intend to limit the definition of **weighting** to merely the evidence of record. Even assuming a broader interpretation than that which is described in *Ukai*, it appears unreasonable to “weight” an already weighted value, since as shown in this recited section of *Ukai*, the “program view measure” is weighted when incorporated into Figure 7. Applicant respectfully submits that one having ordinary skill in the art would not reasonably construe averaging to be weighting, especially in view of the record, nor construe the claims in this nonsensical approach (e.g., multiple levels of weighting) taken by the non-final Office Action. As set forth according to well-established case law,

**\*\*>Although<** claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, **\*>415 F.3d 1303, 1313<**, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*).

Since averaging would be viewed by one having ordinary skill in the art as an entirely different concept than weighting, as evidenced by the record, and that the construction alleged in the non-final Office Action is nonsensical and unreasonable, Applicant respectfully submits that the rejection should be withdrawn for this additional and separate reason.

Continuing, the non-final Office Action (pages 7-8) alleges the following with regard to the claimed overall user preference score (emphasis in original):

Ukai also discloses determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of weighted scores associated with each of the plurality of tracked viewing parameters for the user (see **Figure 7 and Column 6, Lines 21-52 for the system calculating a**

preference measure conversion table 700 for estimating degrees of viewer's preference for programs to be broadcasted, where the system further calculates a weighted program view measure 703 which is determined using the program view measure 504). *The examiner further notes that the total number of programs represents a weighted linear combination because if one user [watches]sic a program 19 times and a second user watches a program 10 times, this represents a different weight in regards to the interest the user has in the program.*

Applicant respectfully submits that it is unclear from the non-final Office Action what constitutes the claimed **overall user preference score**, and hence respectfully requests clarification in any further action not constituting an allowance. Applicant will assume for the sake of argument that the alleged equivalent to **overall user preference score** is intended by the non-final Office Action to be the "total view score 714" in Figure 7. The rejection of the claim features, **weighting of scores**, appears to rely on the "program view measure 504" of Figure 5 as set forth above. As explained above, the program view measures do not constitute **the weighted scores** as claimed. However, as set forth in col. 6, lines 34-38 of *Ukai* (reproduced above), the program view measure 504 appears to be weighted (703). The weighted program view 703 is combined with other elements in Table 700 (Figure 7) to compute a total view score 714 (e.g., see col. 8, line 54 – col. 9, line 20 of *Ukai*), but clearly the computation for 714 does not involve a linear combination of weighted program view measures 703 (assuming *arguendo* equivalent to the claimed **overall user preference score**), but only one. For at least this additional reason, Applicant respectfully requests that the rejection be withdrawn.

Further, Applicant is perplexed by the allegation on pages 7-8 of the non-final Office Action that the "total number of programs represents a weighted linear combination." Claim 49 requires a "linear combination of weighted scores," which clearly is not represented by a number of programs 603. If the intent of this rejection is to say that the specific view scores somehow represents the claimed weighted scores through incorporation of the number of programs in the computation of specific view scores, then again, one having ordinary skill in the art would need to unreasonably construe *Ukai* to implement multiple levels of weight-application (e.g., to view

measure 504, to specific view scores 604, and to the weighted program view measure 702). This multi-level application of weights is simply not supported in *Ukai*, especially in view of the fact that when *Ukai* intends to weight a value, it expressly manifests the language to convey that concept. At best, the approach taken by the non-final Office Action is based on improper hindsight that attempts to use Applicant's claims as a map to piece-meal the rejection of individual claim elements. For this additional reason, Applicant respectfully requests that the rejection be withdrawn.

Since independent claim 49 is allowable, Applicant respectfully submits that claims 50-65, 68-73 and 75-94, and 113-115 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicant respectfully requests that the rejection of claims 50-65, 68-73 and 75-94, and 113-115 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 51 and 52 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 51 and 52. Specifically, Applicant's claims 51 and 52 provide as follows (emphasis added):

51. The system of claim 49, where ***the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user.***

52. The system of claim 49, where ***the user preference is determined based on a duration and a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user.***

The non-final Office Action (page 8), like the final rejection (pages 4-5), alleges that "*Ukai* discloses that the user preference is determined based on a frequency that a service characterized by one or more of the plurality of viewing parameters is presented to the user (see Figure 6 for determining a user preference 604 based on a number of programs 603 viewed)" (emphasis in original). This rebuttal argument from the previous response has not been addressed in the non-final Office Action. Applicant respectfully submits that "a frequency

that a service ... is presented to the user” is not the same as a number of programs viewed. Frequency implies a per-time period basis, which *Ukai* fails to teach.

Further, the non-final Office Action (page 9) refers to the rejection of claims 2 and 3 (e.g., claims 50-51) on page 8 for alleged support in *Ukai* for anticipation of the above-emphasized claim features. The rejection appears to allege that based on 404 (view time period) and 604 (specific view score), the above-emphasized features are shown. Applicant respectfully disagrees, and notes that *Ukai* does not teach or suggest that view time period 404 is determined based on “a frequency that a service ... is presented to the user” as recited in claims 51 and 52. Again, frequency implies a per time period basis that is absent in *Ukai*.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 51 and 52. Therefore, Applicant respectfully requests that the rejections of claims 51 and 52 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claim 55 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claim 55. Specifically, Applicant’s claim 55 provides as follows (emphasis added):

55. The system of claim 49, where ***the user preference conflicts with another user preference.***

The non-final Office Action alleges on page 9 that “*Ukai* discloses that the user preference conflicts with another user preference (see Figure 3 and note that the two programs in table 300 are show at two overlapping/conflicting time periods in table entries 303)” (emphasis in original). However, the Advisory Action on page 2 states that “*Ukai* clearly teaches determining a user preference (view time period 404 in Figure 4) for each of the plurality of viewing parameters (each program name in Figure 4)” (emphasis in original). As such, the Advisory Action appears to allege that view time period 404 corresponds to “a user preference”. Applicant respectfully submits that *Ukai* does not teach or suggest that a view time period 404

“conflicts with another” view time period 404. Further, the table 300 is based on an EPG, and does not yet correspond to user preferences as derived from Figure 6 of *Ukai*. To allege otherwise is to say that everything in an EPG is a user preference, which obviates the need for the invention disclosed in *Ukai* and hence is an improper and unreasonable construction.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claim 55. Therefore, Applicant respectfully requests that the rejection of claim 55 be withdrawn.

The non-final Office Action does not adequately address the features of claims 59-61, nor does the previous action. The MPEP points out in § 707.07(d) under “Improperly Expressed Rejections” that:

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

Applicant submits that the rejection of claims 49 and 58 (e.g., 1 and 9 for the corresponding method claim set features) is not equally applicable to claims 59-61 because each claim contains different features. Specifically, Applicant’s claims 59-61 provide as follows (emphasis added):

59. The system of claim 58, where ***the preference adaptive mode is activated via a switch located on a remote control device.***

60. The system of claim 49, where ***user preference is determined based on user input.***

61. The system of claim 60, where ***the user input indicates a preference for one or more of the plurality of viewing parameters.***

Applicant respectfully submits that the features recited and emphasized above in claims 59-61 are not included in claims 49 and 58. As such, the final Office Action fails to present a *prima facie* case of obviousness against claims 59-61 for at least the reason that it fails to articulate a finding that the cited references include each element claimed. Accordingly, Applicant respectfully requests that the rejection of claims 59-61 be withdrawn.

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully requests that the rejection of claims 62 and 63 be withdrawn for at least the reason that *Ukai* fails to disclose, teach, or suggest at least the features recited and emphasized below in claims 62 and 63. Specifically, Applicant's claims 62 and 63 provide as follows (emphasis added):

62. The system of claim 60, where ***the user input indicates a preference against one or more of the plurality of viewing parameters.***

63. The system of claim 60, where ***the user input indicates*** a preference for a first viewing parameter and ***a preference against a second viewing parameter***, said first and second viewing- parameters comprise the plurality of viewing parameters.

The non-final Office Action (page 10) and final Office Action (page 6) alleges that “*Ukai* discloses that the user input indicates a preference against one or more of the plurality of viewing parameters (see Figure 5 for the user viewing a program for a first time and second time, thereby showing entering a first time against a second time)” (emphasis in original). However, the Advisory Action on page 2 states that “the view time period represents how interested the user [is] in the television program based on how long the user watches the television program.” Thus, Applicant respectfully submits that “viewing a program” is not the same as “indicat[ing] a preference against one or more ... viewing parameters”. Further, Applicant respectfully submits that *Ukai* does not teach or suggest “indicat[ing] a preference against one or more ... viewing parameters”.

For at least the reasons described above, *Ukai* fails to disclose, teach or suggest all of the features recited in claims 62 and 63. Therefore, Applicant respectfully requests that the rejections of claims 62 and 63 be withdrawn.

## **II. Claim Rejections under 35 U.S.C. §103(a)**

Claims 25, 46-48, 74 and 95-97 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ukai*. Applicant respectfully traverses this rejection as applied to pending claims 25, 46-48, 74 and 95-97.



The M.P.E.P. § 2100-116 states:

Office policy is to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. 103. . . the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

In the present case, it is respectfully submitted that a *prima facie* case for obviousness is not established using the art of record.

#### **A. Dependent Claims 25**

For the reasons discussed in section IA above, *Ukai* does not teach or suggest either “weighting the scores” or “determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 1. The addition of *Alexander et al.* (U.S. Pat. No. 6,177,931, hereafter “*Alexander*”) does not overcome these deficiencies. Even assuming *arguendo Alexander* teaches that the “present invention is an improvement on the electronic program guide (EPG)” (col. 2, lines 64-65), *Alexander* does not disclose or suggest “tracking the user preference by assigning a score to each of the plurality of viewing parameters”, much less either “weighting the scores” or “determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 1.

In addition, the non-final Office Action states on page 5 that “the examiner has taken Official Notice to the fact that preference data can be stored at a headend...*Alexander et al.* (U.S. Patent No. 6,177,931) teaches that user preferences can be transmitted back to a

headend for further analysis (**Column 29, Lines 12-36**)” (emphasis in original). Specifically, the cited section of *Alexander* teaches:

2. Analyzing and characterizing viewer profile information.

The viewer profile information (data collected concerning, and surrounding, a viewer's interaction with the television, the EPG (including the recording and watching functions), the Internet, the World Wide Web, and any other sources of information external to the EPG, but through which the viewer interact)) can be sent to a computer at the head end of television distribution for analysis, or in the alternative, can be analyzed by the EPG.

Information about the viewer is captured on an ongoing basis. Similarly, viewer profile data is updated on an ongoing basis. Accordingly, the viewer profile analysis program (the "Profile Program"), can be repeated at some time interval to incorporate additional information about the viewer that has been captured since the last analysis. Alternatively, the Profile Program is a real time program that processes each discrete item of information about a viewer as the data is captured.

The viewer profile analysis program (the "Profile Program"), may be resident at the head end, in the Internet, included as part of the EPG, or distributed among these various possible locations. The Profile Program performs a variety of different types of analysis on the viewer profile data.

Even assuming *arguendo Alexander* teaches that “viewer profile information ... can be sent to a computer at the head end of television distribution for analysis” (col. 29, lines 14-20), the cited section does not disclose or suggest “data identifying the user preference is stored within a headend device” as recited in claim 25. As set forth in MPEP § 2144.03 and according to well-established Federal case law (emphasis added in first paragraph below):

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Applicant respectfully submits that *Alexander*, as cited by the non-final Office Action, fails to provide “instant and unquestionable demonstration as to defy dispute.” Thus, “data identifying the user preference is stored within a headend device”, as recited in claim 25, does not implicitly

follow from the teachings of *Ukai* in light of the knowledge of those having ordinary skill in the art. Even assuming, *arguendo*, that *Alexander* teaches that preference data can be stored at a headend, Applicant respectfully submits that the teachings of a single reference does not make the feature well-known. Accordingly, Applicant respectfully requests that the assertions with regard to official notice be withdrawn.

Further, the non-final Office Action (page 13) alleges that “it would have been obvious to a person of ordinary skill in the art, to modify the program selection system, as taught by *Ukai*, using preference data stored at a headend, as taught by the examiner’s Official Notice, for the purpose of requiring less storage by a client device, therefore being able to provide cheaper client devices to consumers.” The non-final Office Action (page 5) also adds further allegations to support processing at the headend pertaining to lower cost receivers. However, this alleged obviousness is belied by the anticipated benefits described in col. 18, lines 21-34 of *Ukai*. That is, how is storing the preference data at a headend going to help a user when he or she is mobile and requiring local storage? Certainly, the benefits alleged by the non-final Office Action are quite contrary to the requirements needed for local storage, as set forth in *Ukai*. Accordingly, since the arguments presented to support the alleged obviousness of *Ukai* and *Alexander* for the claimed features are unreasonable, Applicant respectfully requests that the rejection be withdrawn for this additional and separate reason.

Because independent claim 1 is allowable over *Ukai* in view of *Alexander*, Applicant respectfully submits that claim 25 is allowable for at least the reason that it depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claim 25 be withdrawn.

**B. Dependent Claims 46-48**

For the reasons discussed in section IA above, *Ukai* does not teach or suggest either “weighting the scores” or “determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 1. The addition of *Block et al.* (U.S. Pat. No. 6,675,384, hereafter “*Block*”) does not overcome these deficiencies. Even assuming *arguendo Block* teaches that the “present invention relates ... to a system and method for information labeling and control in which a user can control access to information based on its content” (col. 1, lines 6-9), *Block* does not disclose or suggest “tracking the user preference by assigning a score to each of the plurality of viewing parameters”, much less either “weighting the scores” or “determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 1. Because independent claim 1 is allowable over *Ukai* in view of *Block*, Applicant respectfully submits that claims 46-48 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully submits that a *prima facie* case of obviousness against claims 46-48 has not been presented. Specifically, MPEP § 2143.03 states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In the present case, Applicant’s claims 46-48 provide as follows (emphasis added):

46. The method of claim 45, where ***the result comprises not tuning to the user identified television service.***

47. The method of claim 46, where ***the result comprises prompting a user to provide additional input.***

48. The method of claim 47, where ***the additional input comprises a personal identification number (PIN).***

While the non-final Office Action acknowledges on page 13 that “Ukai ... fails to teach a conditional access system that will not tune to a program selection unless a user enters his/her PIN/password”, neither the final Office Action, the Advisory Action, nor the non-final Office Action even alleges that the features recited and emphasized above in claims 46-48 are disclosed or suggested by any of the cited references. Applicant has emphasized this omission in the prior response. Thus, for at least the reason that the Office Actions fail to articulate a finding that the cited references include each element claimed, Applicant respectfully requests that the rejection of claims 46-48 be withdrawn.

Further, the non-final Office Action states on page 5 that “the examiner has taken Official Notice to the fact that parental control programs commonly reside on television control devices...Block et al. (U.S. Patent No. 6,675,384) teaches a parental control program resident on a television receiver device (**see element 100 and 110 in Figure 1**)” (emphasis in original). Specifically, *Block* teaches:

The viewer station equipment 20 may include a tuner 60 or program selector 70 for receiving the program signal, a demodulator 80 and/or decoder 90 for demodulating and decoding the received program signal, a viewing control unit 100 which allows a viewer to control access to the received program signal by generating various local labels, a label interpretation unit 110 which evaluates and compares the locally generated and transmitted labels, an access control unit 120 which controls access to the program signal, and a modulator 130 for modulating the access controlled program signal onto a suitable carrier frequency prior to transmission to the TV antenna input.

(Col. 3, line 62 through col. 4, line 7). Applicant respectfully submits that there is no mention or suggestion of “parental control program” in this section or elsewhere in *Block*. As set forth in MPEP § 2144.03 and according to well-established Federal case law (emphasis added in first paragraph below):

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Thus, Applicant respectfully submits that *Block*, as cited by the non-final Action, fails to provide "instant and unquestionable demonstration as to defy dispute." Even assuming, *arguendo*, that *Block* teaches a parental control program, Applicant respectfully submits that the teachings of a single reference does not make the feature well-known. Accordingly, Applicant respectfully requests that the assertions with regard to official notice be withdrawn.

For at least the reasons described above, *Ukai* in view of *Block* fails to disclose, teach or suggest all of the features recited in claims 46-48. Therefore, Applicant respectfully requests that the rejections of claims 46-48 be withdrawn.

### **C. Dependent Claim 74**

For the reasons discussed in section IB above, *Ukai* does not teach or suggest either "logic for weighting the scores" or "logic for determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user" as recited in amended claim 49. The addition of *Alexander et al.* (U.S. Pat. No. 6,177,931, hereafter "*Alexander*") does not overcome these deficiencies. While *Alexander* teaches that the "present invention is an improvement on the electronic program guide (EPG)" (col. 2, lines 64-65), *Alexander* does not disclose or suggest "logic for tracking the user preference by assigning a score to each of the plurality of viewing parameters", much less either "logic for weighting the scores" or "logic for determining an overall user preference score for the plurality of tracked

viewing parameters based on a linear combination of weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 49.

In addition, the non-final Office Action states on page 5 that “the examiner has taken Official Notice to the fact that preference data can be stored at a headend...Alexander et al. (U.S. Patent No. 6,177,931) teaches that user preferences can be transmitted back to a headend for further analysis (**Column 29, Lines 12-36**)” (emphasis in original). Specifically, the cited section of *Alexander* teaches:

2. Analyzing and characterizing viewer profile information.

The viewer profile information (data collected concerning, and surrounding, a viewer's interaction with the television, the EPG (including the recording and watching functions), the Internet, the World Wide Web, and any other sources of information external to the EPG, but through which the viewer interact)) can be sent to a computer at the head end of television distribution for analysis, or in the alternative, can be analyzed by the EPG.

Information about the viewer is captured on an ongoing basis. Similarly, viewer profile data is updated on an ongoing basis. Accordingly, the viewer profile analysis program (the "Profile Program"), can be repeated at some time interval to incorporate additional information about the viewer that has been captured since the last analysis. Alternatively, the Profile Program is a real time program that processes each discrete item of information about a viewer as the data is captured.

The viewer profile analysis program (the "Profile Program"), may be resident at the head end, in the Internet, included as part of the EPG, or distributed among these various possible locations. The Profile Program performs a variety of different types of analysis on the viewer profile data.

Even assuming *arguendo Alexander* teaches that “viewer profile information ... can be sent to a computer at the head end of television distribution for analysis” (col. 29, lines 14-20), the cited section does not disclose or suggest “data identifying the user preference is stored within a headend device” as recited in claim 74. As set forth in MPEP § 2144.03 and according to well-established Federal case law (emphasis added in first paragraph below):

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Applicant respectfully submits that *Alexander*, as cited by the non-final Office Action, fails to provide “instant and unquestionable demonstration as to defy dispute.” Thus, “data identifying the user preference is stored within a headend device”, as recited in claim 74, does not implicitly follow from the teachings of *Ukai* in light of the knowledge of those having ordinary skill in the art. Even assuming, *arguendo*, that *Alexander* teaches that preference data can be stored at a headend, Applicant respectfully submits that the teachings of a single reference does not make the feature well-known. Accordingly, Applicant respectfully requests that the assertions with regard to official notice be withdrawn.

Further, the non-final Office Action (page 13) alleges that “it would have been obvious to a person of ordinary skill in the art, to modify the program selection system, as taught by *Ukai*, using preference data stored at a headend, as taught by the examiner’s Official Notice, for the purpose of requiring less storage by a client device, therefore being able to provide cheaper client devices to consumers.” The non-final Office Action (page 5) also adds further allegations to support processing at the headend pertaining to lower cost receivers. However, this alleged obviousness is belied by the anticipated benefits described in col. 18, lines 21-34 of *Ukai*. That is, how is storing the preference data at a headend going to help a user when he or she is mobile and requiring local storage? Certainly, the benefits alleged by the non-final Office Action are quite contrary to the requirements needed for local storage, as set forth in *Ukai*.

Accordingly, since the arguments presented to support the alleged obviousness of *Ukai* and *Alexander* for the claimed features are unreasonable, Applicant respectfully requests that the rejection be withdrawn for this additional and separate reason.

Because independent claim 49 is allowable over *Ukai* in view of *Alexander*, Applicant respectfully submits that claim 74 is allowable for at least the reason that it depends from an



allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

Therefore, Applicant respectfully requests that the rejection of claim 74 be withdrawn.

**D. Dependent Claims 95-97**

For the reasons discussed in section IB above, *Ukai* does not teach or suggest either “logic for weighting the scores” or “logic for determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 49. The addition of *Block et al.* (U.S. Pat. No. 6,675,384, hereafter “*Block*”) does not overcome these deficiencies. While *Block* teaches that the “present invention relates ... to a system and method for information labeling and control in which a user can control access to information based on its content” (col. 1, lines 6-9), *Block* does not disclose or suggest “logic for tracking the user preference by assigning a score to each of the plurality of viewing parameters”, much less either “logic for weighting the scores” or “logic for determining an overall user preference score for the plurality of tracked viewing parameters based on a linear combination of the weighted scores associated with each of the plurality of tracked viewing parameters for the user” as recited in amended claim 49. Because independent claim 49 is allowable over *Ukai* in view of *Block*, Applicant respectfully submits that claims 95-97 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

Notwithstanding, and in addition to, the arguments discussed above, Applicant respectfully submits that a *prima facie* case of obviousness against claims 95-97 has not been presented. In the present case, Applicant’s claims 95-97 provide as follows (emphasis added):

95. The system of claim 94, where ***the result comprises not tuning to the user identified television service.***

96. The system of claim 95, where ***the result comprises prompting a user to provide additional input.***

97. The system of claim 96, where ***the additional input comprises a personal identification number (PIN)***.

While the non-final Office Action acknowledges on page 13 that “Ukai ... fails to teach a conditional access system that will not tune to a program selection unless a user enters his/her PIN/password”, neither the final Office Action, the Advisory Action, nor the non-final Office Action even alleges that the features recited and emphasized above in claims 95-97 are disclosed or suggested by any of the cited references. Applicant has emphasized this omission in the prior response. Thus, for at least the reason that the Office Actions fail to articulate a finding that the cited references include each element claimed, Applicant respectfully requests that the rejection of claims 95-97 be withdrawn.

Further, the non-final Office Action states on page 5 that “the examiner has taken Official Notice to the fact that parental control programs commonly reside on television control devices...Block et al. (U.S. Patent No. 6,675,384) teaches a parental control program resident on a television receiver device (**see element 100 and 110 in Figure 1**)” (emphasis in original). Specifically, *Block* teaches:

The viewer station equipment 20 may include a tuner 60 or program selector 70 for receiving the program signal, a demodulator 80 and/or decoder 90 for demodulating and decoding the received program signal, a viewing control unit 100 which allows a viewer to control access to the received program signal by generating various local labels, a label interpretation unit 110 which evaluates and compares the locally generated and transmitted labels, an access control unit 120 which controls access to the program signal, and a modulator 130 for modulating the access controlled program signal onto a suitable carrier frequency prior to transmission to the TV antenna input.

(Col. 3, line 62 through col. 4, line 7). Applicant respectfully submits that there is no mention or suggestion of “parental control program” in this section or elsewhere in *Block*. As set forth in MPEP § 2144.03 and according to well-established Federal case law (emphasis added in first paragraph below):

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as

to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Thus, Applicant respectfully submits that *Block*, as cited by the non-final Action, fails to provide "instant and unquestionable demonstration as to defy dispute." Even assuming, *arguendo*, that *Block* teaches a parental control program, Applicant respectfully submits that the teachings of a single reference does not make the feature well-known. Accordingly, Applicant respectfully requests that the assertions with regard to official notice be withdrawn.

For at least the reasons described above, *Ukai* in view of *Block* fails to disclose, teach or suggest all of the features recited in claims 95-97. Therefore, Applicant respectfully requests that the rejections of claims 95-97 be withdrawn.

## CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-16, 20-25, 27-65, 69-97, and 112-115 be allowed to issue. Any statements in the non-final Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all allegations of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the final Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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